

ESTTA Tracking number: **ESTTA596933**Filing date: **04/07/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	University of Southern California
Granted to Date of previous extension	05/03/2014
Address	University Park CampusADM 352 Mail Code 5013 Los Angeles, CA 90089-5013 UNITED STATES
Attorney information	Michael Adler Tantalo & Adler LLP 1901 Avenue of the Stars, Suite 1000 Los Angeles, CA 90067 UNITED STATES madler@ta-llp.com Phone:310-734-8695

Applicant Information

Application No	86060018	Publication date	03/04/2014
Opposition Filing Date	04/07/2014	Opposition Period Ends	05/03/2014
Applicant	SCLC, Inc. 7500 E. Columbia Street Evansville, IN 477159127 GERMANY		

Goods/Services Affected by Opposition

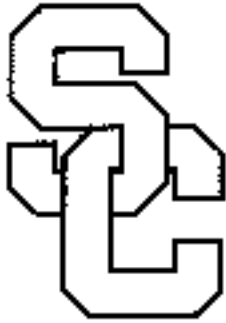
Class 035. First Use: 2013/05/24 First Use In Commerce: 2013/05/24
All goods and services in the class are opposed, namely: Retail stores services in the field of footwear

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2683137	Application Date	02/22/2002
Registration Date	02/04/2003	Foreign Priority Date	NONE
Word Mark	S C		

Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Metal frames for metal license plates; and metallic car emblems</p> <p>Class 016. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Decals; folders; 3-ring binders; personal organizers; calendars; pencils; pens;[erasers;] pencil sharpeners, [pen or pencil holders; desktop business card holders;] note paper; [wrapping paper;] paper napkins; and paper tablecloths</p> <p>Class 018. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Umbrellas; luggage, namely, tote bags, hand luggage, garment bags and overnightbags; shoe bags for travel; fanny packs; toiletry bags sold empty; briefcases; backpacks; duffel bags; wallets; business card cases; luggage tags; animal leashes; and dog collars</p> <p>Class 021. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Porcelain and glass mugs; cups; drinking glasses; shot glasses; commemorative and decorative plates; coasters; paper plates; thermal insulated containers for food or beverage; portable beverage coolers; plastic sports bottles sold empty; and pet bowls</p> <p>Class 024. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Towels; stadium blankets; cloth pennants; and cloth flags</p> <p>Class 025. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Clothing, namely, t-shirts, sweatshirts, polo shirts, warm-up suits, jackets, rain ponchos, sweaters, jerseys, tank tops, shorts, sport shirts, baseball shirts, basketball jerseys, golf sweaters, night shirts, boxer shorts, socks, hats, caps, sport caps, visor caps, beanies and ties</p> <p>Class 028. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Sporting goods, namely, baseballs, footballs, golf balls, golf tees, golf bags,[putters,] golf club covers, [racketcovers, flying discs,] and foam fingers; arcade-type electronic video games; playthings, namely, plush toys, and [ride- on toys; playing cards]</p> <p>Class 035. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 On-line retail store services featuringmen's, women's and children's clothing,footwear, hats, accessories, sporting goods, gifts and novelty items</p> <p>Class 041. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Entertainment services, namely, conducting athletic competitions; organizing intercollegiate, community and national sporting and cultural events; sports instruction; and providing musical, band, dance, theatrical and dramatic performances</p>		

U.S. Registration No.	1844953	Application Date	09/05/1990
Registration Date	07/12/1994	Foreign Priority	NONE

		Date	
Word Mark	SC		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1926/00/00 First Use In Commerce: 1978/00/00 keyrings of non-precious metals; decorative emblems or plates of non-precious metal, for attachment to autos; art work statuary of non-precious metals, all goods being offered and sold to persons through university authorized channels of trade</p> <p>Class 018. First use: First Use: 1926/00/00 First Use In Commerce: 1987/00/00 umbrellas, hand luggage, tote bags, luggage; namely, tote bags, hand luggage, garment bags for travel, and small traveling bags for overnight trips, fanny packs, toiletry bags sold empty, briefcases,back packs, all goods being offered and sold to persons through university authorized channels of trade</p> <p>Class 024. First use: First Use: 1926/00/00 First Use In Commerce: 1987/00/00 towels, blankets, cloth pennants, and cloth flags, all goods being offered and sold to persons through university authorized channels of trade</p> <p>Class 025. First use: First Use: 1926/00/00 First Use In Commerce: 1987/00/00 sweatshirts and T-shirts, all goods being offered and sold at university-controlled outlets</p>		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SC		
Goods/Services	Opposer has used the "SC" mark in connection Opposer's educational and athletic programs, as well as a wide range of apparel.		

Attachments	76374729#TMSN.gif(bytes) 2014-04-07 NTC of Opposition (SIGNED).pdf(62871 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael S. Adler/
Name	Michael S. Adler
Date	04/07/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNIVERSITY OF SOUTHERN
CALIFORNIA,

Opposer,

v.

SCLC, Inc.

Applicant.

Opposition No.

Serial No. 86/060018

Mark: **SC ATHLETICS**

Filed: September 10, 2013

Published: March 4, 2014

NOTICE OF OPPOSITION

Opposer, the University of Southern California, a California non-profit corporation located at University Park, ADM 352, Los Angeles, California hereby files this Notice of Opposition against the captioned application (the "SC ATHLETICS Application"), alleging as follows:

1. Based on Opposer's previous request to extend the time in which to oppose the SC ATHLETICS Application, the deadline to file a Notice of Opposition is May 3, 2014.
2. On knowledge and belief, the SC ATHLETICS Application is owned by SCLC, Inc., a corporation organized under the laws of the State of Delaware having a principal address of 7500 E.Columbia Street, Evansville, IN 47715-9127.
3. According to the current records of the United States Patent and Trademark Office, the SC ATHLETICS Application is an application for registration a mark in typed form

with the wording of "SC ATHLETICS" in International Class 35 for retail store services in the field of footwear.

4. Opposer is the oldest private research university in the Western United States, with a national and international reputation for both academic and athletic excellence. Opposer has not only provided a wide variety of collegiate goods and services on its own account, but Opposer has also licensed various goods and services under the name SC and various related marks for decades. Opposer and its authorized licensees have used the SC mark and various related marks including SC in commerce continuously since at least 1926. Opposer's SC mark is a highly distinctive collegiate mark and through extensive advertising and use, the SC mark has become strongly associated with Opposer's goods and services. In particular, without limitation:

5. Opposer is the owner of Federal Registration 2,683,137 for the mark "S C" for a number of goods and services including International Class 35 for "On-line retail store services featuring men's, women's and children's clothing, **footwear**, hats, accessories, sporting goods, gifts and novelty items." This registration also includes International Class 41 for "Entertainment Services, namely conducting **athletic** competitions, organizing intercollegiate, community and national sporting events; **sports instruction**, and providing musical, band, dance, theatrical and dramatic performances." This registration also includes goods in International Class 28 for "**Sporting goods**, namely, baseballs, footballs, golfballs, golf tees, golf bags, golf club covers, and foam fingers; arcade-type electronic video games; playthings, namely plush toys." This registration also includes goods in International Class 25 for "clothing, namely, t-shirts, sweatshirts, polo shirts, warm-up suits, jackets, rain ponchos, sweaters, jerseys, tank tops, shorts, sport shirts, baseball shirts, basketball jerseys, golf sweaters, night shirts, boxer shorts, socks, hats, caps, sport caps, visor caps, beanies and ties." This registration further

includes goods in International Class 24 for "Towels, stadium blankets, cloth pennants, and cloth flags." This registration further includes goods in International Classes 21, 18, 16 and 12.

Registration No. 2,683,137 is valid, subsisting, and incontestable. Opposer has used the SC mark and various related marks in connection with clothing continuously since at least 1994.

6. Opposer is also the owner of Federal Registration 1,844,953 for the mark "SC" for goods in International Classes 6, 8, 24, and 25. Registration No. 1,844,953 is valid, subsisting, and incontestable. Opposer has used the SC mark and various related marks in connection with the sales of such goods since at least 1987.

7. Opposer is also the owner of common law rights in the mark SC and various related marks arising from Opposer's educational and athletic programs beginning at least as early as 1926. Opposer's common law rights include the use of various forms of the SC mark in both goods and services connected with Opposer's athletics program. Opposer operates its own retail stores and has further manufactured and/or licensed a wide variety of athletic-related goods to others to be sold through a wide variety of retail channels. The use of the SC mark and related marks (whether by Opposer or its licenses) inures to the benefit of Opposer and provides Opposer with additional common law rights upon which Opposer relies in this Opposition.

8. As a result of extensive advertisement, promotion, and sale of goods and services using the SC mark, the mark has gained widespread and favorable public acceptance and recognition. The University of Southern California's SC mark (and related marks) are associated with and identify Opposer.

9. Opposer has developed valuable good will with respect to the SC mark.

10. The SC mark is a famous and distinctive mark, and represents an asset of incalculable value as a symbol of Opposer, the University of Southern California, its quality goods and services, and its goodwill.

11. Opposer believes that it will be damaged by the registration of the Applicant's proposed mark both because an appreciable number of members of the consuming public may improperly assume that Applicant's services are associated with, endorsed by, or affiliated with Opposer and further because registration of the Applicant's proposed mark would lead to tarnishment and/or dilution of Opposer's established registration and common law rights in SC and various related marks. Opposer therefore has a real interest and a direct stake in the outcome of the proceeding and Opposer opposes the registration in whole.

12. Opposer's trademark rights in the SC mark are valid, subsisting and have not been abandoned. Applicant's application was filed claiming a first use date of May 2013, and as such, Opposer's right have priority.

13. Opposer's SC mark and its related marks are similar to the dominant part of Applicant's mark in sight and sound. Moreover, Opposer offers a nationally and internationally famous athletics program which Opposer actively promotes using its SC and related marks. Although Applicant's mark may not create confusion when used locally within Applicant's own "Shoe Carnival" stores in the mid-west, Applicant's proposed national application without any restrictions as to use would create a confusingly similar mark.

14. If Applicant were granted the registration herein opposed, a registration for the SC ATHLETICS mark in typed form would provide Applicant at least a *prima facie* exclusive right to use the term in any reasonable stylization including the various stylizations used by and associated with Opposer. Moreover, if Applicant were granted the registration herein opposed,

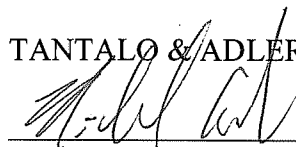
Applicant would thereby obtain at least a *prima facie* exclusive right to use the mark across the nation in any retail context for the sale of footwear. Such registration would cause damage and injury to Opposer.

Therefore, Opposer prays that the application Serial Number 86/060018 be rejected, and that the mark therein sought for the services specified above in International Class 35 be denied and refused.

Dated: April 7, 2014

Respectfully submitted,

TANTALO & ADLER, LLP

A handwritten signature in black ink, appearing to read "Michael S. Adler", is written over a horizontal line.

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Los Angeles, CA 90067
Telephone: (310) 734-8694

Attorneys for Opposer
University of Southern California

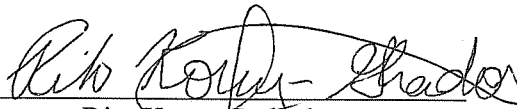
Reference no. 93107-00125

Opposition No. _____

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 7th day of April, 2014.

Gary K. Price
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700 S. Green River Rd, Ste 2000
Evansville, Indiana 47715-7907


Rita Kouy-Gadosh